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| 08/520,662 | 08/28/95 | DOMINGUEZ DE WALTER L | HOE-94/F-249 |

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EXAMINER

ACQUAH, S

ART UNIT

PAPER NUMBER

1207

DATE MAILED: 07/29/97

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 16

Application Number: 08/520,662

Filing Date: 08/28/95

Appellant(s): Ligia Dominguez et al

John M Genova

For Appellant

EXAMINER'S ANSWER

Art Unit: 1207

This is in response to appellant's brief on appeal filed 04/14/97.

A statement identifying the real party in interest is contained in the brief.

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 1-7, 10-15, 19-26 and 29.

Claims 8, 9, 16-18, 27 and 28 are withdrawn from consideration as not directed to the elected invention.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on 11/04/96 has been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

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(7) Grouping of Claims

The brief includes a statement that the appealed claims stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

| <u>Number</u> | <u>Name</u> | <u>Date</u> |
|---------------|------------------|-------------|
| 4,208,527 | HORLBECK et al. | 06/1980 |
| 4,131,601 | HASHIMOTO et al. | 12/1978 |

(10) New Prior Art

No new prior art has been applied in this examiner's answer.

(11) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-7, 10-15, 19-26 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Horlbeck et al. and Hashimoto et al.

Horlbeck et al. disclose process for preparing high molecular weight PET in two stages as claimed, wherein terephthalic is reacted with ethylene glycol in the presence of 35-290 ppm of Mn and 6-95 ppm of cobalt to give low molecular weight precondensate which is then polycondensed in the presence of phosphorous compounds, germanium and titanium compounds to provide a product with improved color characteristics.

Claim 1 is representative of the claimed invention, and basically is a two stage process comprising esterification of an aromatic dicarboxylic acid with an aliphatic diol in the presence of a transesterification catalyst, with subsequent polycondensation in the second stage in the presence of a complexing phosphorous compound, optionally in the presence of cobalt compound, and further in the presence of titanium compound.

It is herein pointed out that cobalt is an optional component because Appellants had previously argued that:

none of the references teaches the distinguishing feature that the cobalt compound, which is added after transesterification, is not completely complexed. Applicants have discovered that a partial deactivation of the cobalt compound surprising

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leads to a drastic improvement
in reproducibility and rates
of polycondensation ...

It is the Examiner's position that Appellants' argument is not convincing because said cobalt compound is an optional ingredient as indicated above, thus when it is absent in the composition, then its effect would likewise be absent. Similarly, Co being added in stage 1 as shown in the prior art or in stage 2 as claimed is irrelevant because it is an optional ingredient and may not be used at all. Also, Appellants' argument that the polycondensation catalyst in the prior art is Ge/Ti while the claims require Ti is without merit because the claims do not exclude other compounds such as Ge. See also column 6, Table 1 wherein the products made by the prior art process and composition have features and characteristics essentially as claimed.

The prior art to Hashimoto et al. discloses a process and composition for preparing linear, highly polymerized polyesters by two stages as claimed.

Appellants argue that this prior art is different because Co is added as a catalyst during the esterification or transesterification whereas in the claims Co is optionally added to improve the color shade of the product and therefore it does not contribute to the reaction. As indicated above, and as admitted by Appellant, Co is an optional ingredient and

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therefore, it is irrelevant whether it is added as a catalyst or to change the color shade, if it is not present its effect is absent.

Appellant further argue that:

Moreover, Hashimoto et al. teach that half or lesser amount of the preformed titanate catalyst may be replaced by an antimony compound... This teaching is in direct contrast to the claimed invention which is directed to a process for preparation of antimony-free polyesters. Therefore, the Examiner errs when he states ... that the prior art does not "disclose the use of antimony" (emphasis original).

Attention is herein directed to the use of catalyst "may be replaced. The prior art clearly teaches that part of the titanium catalyst may be replaced at the option of the ordinary practitioner. Thus, when the practitioner chooses not to use antimony, then the composition is antimony-free as claimed.

In essence, it is the Examiner's position that the prior arts have features and characteristics as claimed.

(12) New Ground of Rejection

This examiner's answer does not contain any new ground of rejection.

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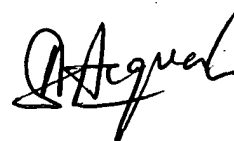
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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

S.A. Acquah/vsh
07/27/97



**SAMUEL A. ACQUAH
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Appeal concedes
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